UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,896	09/14/2006	Harri Heine	297-012643-US (PAR)	1801

2512   7590   05/28/2008
PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER
WANG-HURST, KATHY W

ART UNIT	PAPER NUMBER
4173	

MAIL DATE	DELIVERY MODE
05/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 September 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/14/2006 and 1/15/2008</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statements (IDS) submitted on 9/14/2006 and

1/15/2008 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statement is being considered by the examiner.

Priority

2.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 17 and 18 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claims 17 and 18 are directed to a

software. However, a software is drawn to functional descriptive material which is not

statutory. MPEP § 2106.01, Section I, states:

> "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

> "Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

"In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory."

To overcome this rejection, examiner suggests that any claims directed to the software be amended such that they embody the functional descriptive material on a computer-readable medium.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1, 2, 4, 7-11, 13, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by **Tsunoda (US 6023231).**

Regarding claim 1, Tsunoda discloses a device for composing a multimedia message for which a network defines a given multimedia message size limit for enabling transmission of the multimedia message in said network, **characterized** in that the device includes an application program for creating the multimedia message **(col. 3 lines 15-19)**, and that in the device, there is registered said multimedia message size limit defined by the network **(col. 2 lines 29-34),** so that said multimedia message size limit is available for the application program, and that the device includes means for producing before an attempt for transmission of the multimedia message in said network is done an indication to a user of the device as a response to a situation in

which a size of the multimedia message exceeds said multimedia message size limit **(col. 2 lines 1-5)**.

Regarding claim 2, Tsunoda discloses a device according to claim 1, characterized in that the device includes means for inquiring and/or receiving the multimedia message size limit from the network **(col. 2 lines 29-34)**.

Regarding claim 4, Tsunoda discloses a device according to claim 1, characterized in that the device is provided with at least one of the following: a memory unit, an application program, a multimedia message application or a system file, for recording the multimedia message size limit **(col. 3 lines 14-29 and col. 4 lines 49-62).**

Regarding claim 7, Tsunoda discloses a device according to claim 1, characterized in that the device includes means for comparing the multimedia message size limit with the size of a multimedia message composed by the application program, and for indicating the detected size difference in the application program either visually and/or by means of sound **(col. 1 lines 55-67 - col. 2 lines 1-2)**.

Regarding claim 8, Tsunoda discloses a device according to claim 1, characterized in that the device is the user's mobile device **(Abstract and col. 1 lines 5-8)**.

Regarding claim 9, Tsunoda discloses a device according to claim 1, characterized in that the device is a mobile station **(Abstract and col. 1 lines 5-8)**.

Regarding claim 10, Tsunoda discloses a method for composing a multimedia message for which a network defines a given multimedia message size limit for enabling transmission of the multimedia message in said network, **characterized** in that the multimedia message is created by means of an application program **(col. 4 lines 48-62)**, the multimedia message size limit defined by the network is made available for the application program**(col. 1 lines 55-67 - col. 2 lines 1-5)**, the application program looks up the information concerning the multimedia message size limit**(col. 1 lines 55-67 - col. 2 lines 1-5)**, and as a response to a situation in which a size of the multimedia message exceeds the multimedia message size limit the application program produces an indication to a user of the method before an attempt for transmission of the multimedia message in said network is done**(col. 2 lines 1-5)**.

Regarding claim 11, Tsunoda discloses a method according to claim 10, characterized in that the multimedia message size limit defined by the network is inquired and/or received from the network **(col. 2 lines 29-34)**.

Regarding claim 13, Tsunoda discloses a method according to claim 10, characterized

in that the multimedia message size limit is registered in one of the following: a memory

unit, an application program, a multimedia message application or a system file **(col. 3**

lines 14-29).

Regarding claim 16, Tsunoda discloses a method according to claim 10, characterized

in that the multimedia message size limit defined by the network is compared with the

real size of the multimedia message composed by the application program, and when

the multimedia message is equally large or larger than the defined multimedia message

size limit, the situation is indicated in the application program either visually and/or by

sound **(col. 2 lines 1-2)**.

Regarding claim 17, Tsunoda discloses a software for composing a multimedia

message for which a network defines a given multimedia message size limit for

enabling transmission of the multimedia message in said network, characterized in that

the software includes software means for obtaining the multimedia message size limit

defined by the network for the multimedia message, software means for comparing a

size of the multimedia message with the multimedia message size limit, and software

means for producing before an attempt for transmission of the multimedia message in

said network is done an indication to a user of the software as a response to a situation

in which the size of the multimedia message exceeds the multimedia message size limit

(col. 1 lines 46-67 - col. 2 lines 1-5 and col. 3 lines 14-29).

Regarding claim 18, Tsunoda discloses a software according to claim 17, characterized

in that the software includes software means for requesting and/or receiving from the

network the multimedia message size limit defined by the network for the multimedia

message **(col. 2 lines 29-34)**.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 3, 5, 6, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tsunoda in view of **Chander et al. (US 7174177)**, herein after

referred as Chander.

Regarding claim 3, Tsunoda discloses a device according to claim 2, characterized in

that the device includes means for inquiring and/or receiving the multimedia message

size limit **(col. 2 lines 29-34).** Tsunoda fails to disclose the device that has means for

inquiring message size limit from at least one of the following: a messaging server, a

home register or a server located on the network bus. Chander teaches a system for

providing indication of maximum payload size in a wireless network from at least one of

the following: a messaging server, a home register or a server located on the network
bus **(col. 2 lines 26-34)**. It would have been obvious to a person having ordinary skill in
the art at the time the invention was made to incorporate the device having means for
inquiring message size limit taught by Chander to the device disclosed by Tsunoda in
order to improve the efficiency of the system since payload size requirement already
resides on the network database server which saves additional queries on the size limit
when sending the message.

Regarding claim 5, Tsunoda discloses a device according to claim 1, characterized in
that the device includes means for inquiring and/or receiving the multimedia message
size limit from the network **(col. 2 lines 29-34)**, but fails to disclose the device having
means for inquiring/receiving the information as a response to switching the device on.
Chander teaches inquiry/receiving the payload size limit when the subscriber powers on
the mobile station **(col. 5 lines 39-49)**. Therefore, it would have been obvious to a
person having ordinary skill in the art at the time the invention was made to incorporate
the means taught by Chander into the means disclosed by Tsunoda in order to improve
the efficiency of the system since no additional payload size queries or processing are
required when sending the message as the size limit information is already available on
the network.

Regarding claim 6, Tsunoda discloses a device according to claim 1, characterized in
that the device includes means for inquiring and/or receiving the multimedia message

size limit from the network **(col. 2 lines 29-34)**, but fails to disclose the

inquiring/receiving the size limit as a response to an observation that the device has

entered the coverage area of a given network or messaging server. Chander teaches

means for inquiring/receiving payload limit when the mobile station has entered the

service area **(col. 5 lines 39-49)**. Therefore, it would have been obvious to a person

having ordinary skill in the art at the time the invention was made to incorporate the

means taught by Chander into the means disclosed by Tsunoda in order to improve the

efficiency of the system since no additional payload size queries or processing are

required when sending the message as the size limit is already obtained when the

mobile station enters a service area.

Regarding claim 12, Tsunoda discloses a method according to claim 11, characterized

in that the multimedia message size limit is defined by the network **(col. 2 lines 29-34)**

but fails to disclose the size limit is inquired and/or received from one of the following: a

messaging server, a home register or a server located on the network bus. Chander

teaches a system for providing indication of maximum payload size in a wireless

network from at least one of the following: a messaging server, a home register or a

server located on the network bus **(col. 2 lines 26-34)**. It would have been obvious to a

person having ordinary skill in the art at the time the invention was made to incorporate

the method inquiring message size limit taught by Chander to the method disclosed by

Tsunoda in order to improve the efficiency of the system since payload size requirement

already resides on the network database which saves additional queries on the size

limit when sending the message.

Regarding claim 14, Tsunoda discloses a method according to claim 10, characterized

in that the multimedia message size limit defined by the network is inquired and/or

received from the network**(col. 2 lines 29-34)**, but fails to disclose that the message

size limit is inquired/received when switching on a device that is capable of processing

multimedia messages. Chander teaches inquiry/receiving the payload size limit when

switching on a device **(col. 5 lines 39-49)**. Therefore, it would have been obvious to a

person having ordinary skill in the art at the time the invention was made to incorporate

the method taught by Chander into the method disclosed by Tsunoda in order to

improve the efficiency of the system since no additional payload size queries or

processing are required when sending the message as the messaging size already

exists on the network.

Regarding claim 15, Tsunoda discloses a method according to claim 10, characterized

in that the multimedia message size limit defined by the network is inquired and/or

received from the network, but fails to disclose the size limit is inquired/received when a

device that is capable of processing multimedia messages enters the coverage area of

a new network or network switching center. Chander teaches means for

inquiring/receiving payload limit when the mobile station has entered the service area

(col. 5 lines 39-49). Therefore, it would have been obvious to a person having ordinary

skill in the art at the time the invention was made to incorporate the means taught by

Chander into the means disclosed by Tsunoda in order to improve the efficiency of the

system since no additional payload size queries or processing are required when

sending the message as the size limit is already obtained when the mobile station

enters a coverage area.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Laumen et al. (US 2003/0081555) discloses a method for extending the flow of

information when transmitting a message.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to KATHY WANG-HURST whose telephone number is

(571)270-5371. The examiner can normally be reached on Monday-Thursday, 7:30am-

5pm, alternate Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Benny Tieu can be reached on (571)272-7490. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/KATHY WANG-HURST/
Examiner, Art Unit 4173*

/Benny Q Tieu/
Supervisory Patent Examiner, Art Unit 4173